

REMARKS/ARGUMENTS

I. Status of the Claims

After entry of the current amendments, claims 12-18, 23-29, 31-96 are pending. Claims 12-18, 23-29, 31-38, 63-65, 68 and 78-96 are currently presented. Claims 39-62, 66-67 and 69-77 are withdrawn. Claims 1-11, 19-22 and 30 are cancelled. Claims 78-96 are new.

II. Claim Amendment

Claim 12 was amended to add the phrase "said glycoPEGylated EPO peptide is made by a method comprising: adding" in lines 3-4 and to delete the phrase "is added" in line 4. The amendment was made to prove antecedent basis for the word "method" used in new dependent claim 85-96.

Claim 27 was amended to replace the word "peptide" in line 2 with the word "glycan".

Claims 14, 15 and 17 were amended to replace the phrase "all of said glycans are" with the phrase "each of said at least one glycan is".

Claims 1-11, 19-22 and 30 were cancelled.

III. New Claims

New dependent claims **78-83** were added to recite exemplary glycoPEGylated EPO peptides in accordance with the invention, in which the nature of the glycan is further defined. Support for the addition of these claims can be found, e.g., in originally filed claims 3-8.

New dependent claim **84** was added to recite an exemplary glycoPEGylated EPO peptide in accordance with the invention, in which the peptide has an amino acid sequence according to SEQ ID NO: 73.

New dependent claims **85-96** were added to recite exemplary glycoPEGylated EPO peptides in accordance with the invention, in which the method used to make the glycoPEGylated EPO peptide is further defined. Support for the addition of these claims can be found, e.g., in originally filed claims 39-41 and 53-62.

IV. Response to Election/Restriction Requirement

The Examiner has issued a restriction requirement under 35 U.S.C. 121 and 372. The Examiner states that the inventions listed as Groups I-V do not relate to a single general inventive concept under PCT rule 13.1 because they are not linked by a special technical feature. The Examiner further states that because a feature found in the prior art cannot be considered a special technical feature and because the claimed composition is known in the art (Glycobiology 1996, 6(2): 217-230; "Hermentin"), "glycosylated EPO" cannot be considered a common technical feature.

The Examiner has restricted the pending claims into the following five groups:

<u>Group #</u>	<u>Claim Numbers</u>
I.	1-38, 63-65 and 68
II.	39-62, 67 and 69
III.	72 and 73
IV.	74-76
V.	77

[Applicants note that claim 66 was not assigned to any of groups I to V and assume that claim 66 resides in Group II as it is directed to a method of making glycoPEGylated EPO peptides.]

Applicants elect **Group I** for prosecution on the merits. The claims of Group I are directed to glycoPEGylated EPO peptides which include a glycan and a poly(ethylene glycol)

(PEG) molecule. Currently presented claims 12-18, 23-29, 31-38, 63-65, 68 and 78-96 fall within Group I.

(A) The cited reference does not disclose Applicant's claimed invention

Applicants submit that the reference cited by the Examiner ("Hermentin") discloses glycopeptides but does not disclose a glycoPEGylated EPO peptide, as currently claimed by Applicants. As a result, "Hermentin" does not disclose Applicants' claimed invention. Because glycoPEGylated EPO peptide is not disclosed by "Hermentin", it can be a special technical feature (e.g. common to Groups I and II).

(B) Groups I and II are linked by common technical features

The election of **Group I** is made with traverse. Applicants submit that the claims of Group I (12-18, 23-29, 31-38, 63-65, 68 and 78-96), which are directed to glycoPEGylated EPO peptides, and the claims of Group II (claims 39-62, 66, 67 and 69), which are directed to methods of making glycoPEGylated EPO peptides, relate to a single general inventive concept under PCT rule 13.1. They are linked by common technical features.

Each of the methods of Group II can be used to make the glycoPEGylated EPO peptide of Group I, which includes a glycan and a poly(ethylene glycol) (PEG) molecule.

For example, the methods of claims 39-62 and the methods of claims 66, 67 and 69 can be used to attach a sugar molecule, which is covalently linked to a PEG molecule onto an EPO peptide, resulting in a glycoPEGylated EPO peptide. Hence, the product of each of the methods of Group II is a glycoPEGylated EPO peptide. As a result, the product, which is produced by the methods of Group II is the same as the composition of Group I.

Therefore, Groups I and Group II are linked through the common technical features:

- (a) glycoPEGylated EPO peptide;
- (b) glycan; and
- (c) PEG molecule covalently linked to glycan/sugar moiety

Because the claims of Group I and II are linked through the above common technical features, Applicants submit that the restriction between Groups I and II is improper. Applicants respectfully ask the Examiner to combine Groups I and II (claims 12-18, 23-29, 31-66 and 78-96) into a single group.

(C) Species Election:

EPO peptide

In case the Examiner should require a specific EPO peptide, Applicants elect the EPO peptide represented by SEQ ID NO: 73 (mature EPO) depicted in Figure 65 of the application.

Glycan and PEG

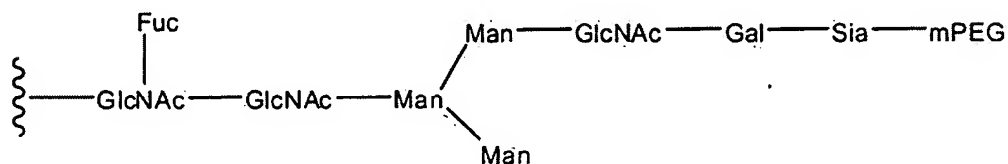
In case the Examiner should require a specific glycan, Applicants elect the glycan depicted in Figure 35A of the specification,

wherein

s, t and u are 0;

r, i, a, e, j and v are 1; and

R is methoxy poly(ethylene glycol) (m-PEG):



In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 10/530,972
Amdt. dated June 9, 2008
Reply to Restriction Requirement dated December 7, 2007

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-442-1793.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Ute Splittgerber', with a long horizontal stroke extending to the right.

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